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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
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| 09 610,134      | 07/05/2000  | Mark Larche          | 5538 1010           | 4389             |

29933 7590 08/27/2002

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EXAMINER

DECLoux, AMY M

| ART UNIT | PAPER NUMBER |
|----------|--------------|
|----------|--------------|

1644

DATE MAILED: 08/27/2002

26

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/610,134

Applicant(s)

LARCHE ET AL.

Examiner

Amy M. DeCloux

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 28 May 2002.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-12 and 15-31 is/are pending in the application.
- 4a) Of the above claim(s) 1-7, 12, 17-23, 25 and 27-31 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 8-11, 15, 16, 24 and 26 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 05 July 2000 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☒ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
- see the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☒ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 5, 12, 14, 24, 25
- 4) ☐ Interview Summary (PTO-413) Paper No. \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

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## DETAILED ACTION

### *Election/Restrictions*

1. Applicant's election with traverse of Group II, claims 8-11, 15-16, 24 and 26 in Paper No. 17, filed 10-11-01, is acknowledged.

The traversal is on the ground(s) that have not been addressed by Applicant. This is not found persuasive because no grounds have been presented.

Applicant's election of the species DR4 and the peptides from Fel d1 in Paper No. 19, filed 12-21-01, is acknowledged. Upon reconsideration the

The requirement is still deemed proper and is therefore made FINAL.

2. Claims 1-7, 12, 17-23, and 25 and 27-31 have been withdrawn from further consideration pursuant to 37 CFR 1.142(b), as being drawn to a nonelected invention, there being no allowable generic or linking claim. Applicant timely traversed the restriction (election) requirement in Paper No. 17, filed 10-11-01.

3. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

### *Drawings*

4. New formal drawings are required in this application because of the reasons outlined in the attached PTO Form 948. Applicant is advised to employ the services of a competent patent draftsman outside the Office, as the Patent and Trademark Office no longer prepares new drawings. The corrected drawings are required in reply to the Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance.

## INFORMATION ON HOW TO EFFECT DRAWING CHANGES

### 1. Correction of Informalities - 37 CFR 1.85

Corrected drawings that are used to make changes incorporated herein identifying indicia, if provided, should include the title of the invention, inventor's name, and application number, or docket number (if any) if an application number has not been assigned to the application. If this information is provided, it must be placed on the front of each sheet and centered within the top margin. If corrected drawings are required in a Notice of Allowability (PTOL 37), the new drawings **MUST** be filed within the **THREE**

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**MONTH** shortened statutory period set for reply in the "Notice of Allowability." Extensions of time may NOT be obtained under the provisions of 37 CFR 1.136 for filing the corrected drawings after the mailing of a Notice of Allowability. The drawings should be filed as a separate paper with a transmittal letter addressed to the Official Draftsperson.

**2. Corrections other than Informalities Noted by Draftsperson on form PTO-948.**

All changes to the drawings, other than informalities noted by the Draftsperson, **MUST** be made in the same manner as above except that, normally, a highlighted (preferably red ink) sketch of the changes to be incorporated into the new drawings **MUST** be approved by the examiner before the application will be allowed. No changes will be permitted to be made, other than correction of informalities, unless the examiner has approved the proposed changes.

**3. Timing of Corrections**

Applicant is required to submit acceptable corrected drawings within the time period set in the Office action. See 37 CFR 1.185(a). Failure to take corrective action within the set (or extended) period will result in **ABANDONMENT** of the application.

***Specification***

5. This application does not contain an abstract of the disclosure as required by 37 CFR 1.72(b). An abstract on a separate sheet is required.

6. The disclosure is objected to because it contains an embedded hyperlink and/or other form of browser-executable code. Applicant is required to delete the embedded hyperlink and/or other form of browser-executable code. See MPEP § 608.01. Specifically a hyperlink is disclosed on page 50, line 2.

7. The disclosure is objected to because of the following informalities: There are blank lines on page 1, line 1 of the specification.  
Appropriate correction is required.

***Priority***

8. Acknowledgment is made of applicant's claim for priority under 35 U.S.C. 119(a)-(d) based upon an application filed in Great Britain (Application No. 9820474.6) on 9-21-1998. It is noted, however, that applicant has not filed a certified copy of the foreign application as required by 35 U.S.C. 119(b).

9. Acknowledgment is made of applicant's claim for priority under 35 U.S.C. 119(a)-(d) based upon an application filed in Great Britain (Application No. 9800445.0) on 1-9-1998. A

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claim for priority under 35 U.S.C. 119(a)-(d) cannot be based on said application, since the United States application was filed more than twelve months thereafter.

### ***Information Disclosure Statement***

The information disclosure statement filed 10-25-00 (Paper No. 5) fails to comply with 37 CFR 1.98(a)(2), which requires a legible copy of each U.S. and foreign patent; each publication or that portion which caused it to be listed; and all other information or that portion which caused it to be listed. It has been placed in the application file, but the information referred to therein has not been considered. Specifically copies of several WO patents listed on the IDS statement were not found by the examiner, as indicated by the attached marked up copy of Applicant's IDS statement. Further the authorship and source of the fifth from the last reference abbreviated as Scrip is not clear. Further, the last three items listed on said IDS statement fail to comply with the provisions of 37 CFR 1.97, 1.98 and MPEP § 609 because said items are searches. It has been placed in the application file, but the information referred to therein has not been considered as to the merits.

### ***Claim Rejections - 35 USC § 112***

10. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

11. Claims 10, 16, 24 and 26 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

A) Claim 10 is indefinite in its recitation of the phrase "for use in medicine" because it is not clear what said phrase means.

B) Claim 24 is indefinite in its recitation of "A peptide when selected by Claim 17." because it is not clear what said claim means.

C) Claim 26 is indefinite because it depends from a non-elected claim (claim 25).

meaning of said phrase is not clear within the context of the sentence.

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***Claim Rejections - 35 USC § 102***

12. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

13. Claims 8-12, and 15 16 and 24 and 26 are rejected under 35 U.S.C. 102(b) as being anticipated by Briner et al PNAS 90:7608-7612 (1993)(IDS).

Briner et al teach a plurality of peptides derived from the polypeptide antigen Fel d 1 chain 1 protein including the peptides IPC-1 and IPC-2 and Fel 1-2 (see entire document, especially page 7611, Figure 3 and Table 2). Briner et al also teaches said peptides in a pharmaceutical composition comprising complete Freund's adjuvant, and that said composition was administered to mice (see entire article, including page 7609, column 1, first paragraph and Figure 3). It is noted that the amino acid sequence of the Fel 1-2 peptide is identical to that of SEQ ID NO:6 encompassed by claim 16 as described in Figure 9 of the instant specification, and therefore inherently possesses the recited limitations of restriction to a class II MHC molecule and is able to induce a late phase response in an individual possessing the given MHC Class II molecule. See MPEP 2112.01 which states

"Where the claimed and prior art products are identical or substantially identical in structure or composition, or are produced by identical or substantially identical processes, a prima facie case of either anticipation or obviousness has been established. In re Best, 562 F.2d 1252, 1255, 195 USPQ 430, 433 (CCPA 1977). "When the PTO shows a sound basis for believing that the products of the applicant and the prior art are the same, the applicant has the burden of showing that they are not." In re Spada, 911 F.2d 705, 709, 15 USPQ2d 1655, 1658 (Fed. Cir. 1990). Therefore, the prima facie case can be rebutted by evidence showing that the prior art products do not necessarily possess the characteristics of the claimed product. In re Best, 562 F.2d at 1255, 195 USPQ at 433."

Therefore the referenced teachings anticipate the claimed invention.

14. No Claim is allowed.

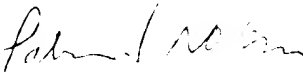
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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Amy M. DeCloux whose telephone number is 703 306-5821. The examiner can normally be reached on M-F 8:00-5:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Christina Chan can be reached on 703 308-3973. The fax phone numbers for the organization where this application or proceeding is assigned are 703 305-3014 for regular communications and 703 872-9307 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703 308-0196.

Amy DeCloux, PhD  
Patent Examiner, Group 1640,  
August 25, 2002

  
Patrick J. Nolan, Ph.D.,  
Primary Patent Examiner, Group 1640,